UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,912	02/06/2004	Constantine A. Domashnev	4461-040040	7385

28289   7590   09/30/2008
THE WEBB LAW FIRM, P.C.
700 KOPPERS BUILDING
436 SEVENTH AVENUE
PITTSBURGH, PA 15219

EXAMINER
SEREBOFF, NEAL

ART UNIT	PAPER NUMBER
3626	

MAIL DATE	DELIVERY MODE
09/30/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 July 2008</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-22</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-22</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment/ Notice to Applicant

1.   In the amendment filed 7/7/2008, the following has occurred. Claim 17 has been

amended. Claims 1 through 22 are pending.

2.   The text of those sections of Title 35, U.S. Code not included in this action can be found

in a prior Office action.

Oath/Declaration

3.   The declaration under 37 CFR 1.132 filed 7/7/2008 is insufficient to overcome the

rejection of claims 1 - 22 based upon claim interpretation as applied under 35 U.S.C. 103(a) as

set forth in the last Office action because: It refer(s) only to the system described in the above

referenced application and not to the individual claims of the application. Thus, there is no

showing that the objective evidence of nonobviousness is commensurate in scope with the

claims. See MPEP § 716.

Claim Rejections - 35 USC § 103

4.   ***Claims 1, 12, 13 and 16*** are rejected under 35 U.S.C 103(a) as being unpatentable over

Munoz et al, U.S. Pre-Grant Publication Number 2002/ 0052760 in view of Henley, U.S. Pre-

Grant Publication 2003/ 0195838.

5.   As per claim 1, Munoz teaches an electronic prescription handling system comprising:

        (a) A first computer configured to transmit a prescription by a physician (figure 14 for

        network design and paragraph 58 for the prescribing physician);

        (b) A server communicatively connected to the first computer and functionally distinct

        therefrom (figure 14, server 332 and pc 306 or third party system 320), wherein the

server is configured to receive the prescription from the first computer, wherein the

server is remote from the first computer (figure 14 where the server is connected through

the Internet as discussed in paragraph 58) and is operated by a service provider (figure 14

#318 and paragraph 72 to show the computer is operated by the service provider);

(c) A first pharmacy having a first pharmacy computer communicatively connected to

the server, wherein the first pharmacy computer is configured to:

- o Retrieve the prescription from the server (figure 14 where the third party may be

  any number of third parties as described in paragraph 72); and

- o Transmit a first bid for the prescription to the server (paragraph 67), wherein the

  first bid is stored on the server (67 where the bid results are compiled or stored);

(d) A second pharmacy having a second pharmacy computer communicatively connected

to the server, wherein the second pharmacy computer is configured to:

- o Retrieve the prescription from the server (figure 14 where the third party may be

  any number of third parties as described in paragraph 72); and

- o Transmit a second bid for the prescription to the server (paragraph 67), wherein

  the second bid is stored on the server (67 where the bid results are compiled or

  stored); and

(e) A second computer communicatively connected to the server (figure 14).

Munoz does not explicitly teach the system wherein

(e) A second computer communicatively connected to the server, wherein the second

computer is <u>operated by a patient and is configured to</u>:

- o <u>Retrieve the first bid and the second bid; and</u>

    o <u>Select one of (i) the first bid, and (ii) the second bid;</u>

    o <u>Such that</u>

       ■ <u>When the first bid is selected, the first pharmacy fills the prescription; and</u>

       ■ <u>When the second bid is selected, the second pharmacy fills the prescription.</u>

However, Henley teaches the system wherein

   (e) A second computer communicatively connected to the server, wherein the second computer is operated by a patient and is configured to (figure 8 and paragraphs 63 and 83 where the buyer is a patient):

    o Retrieve the first bid and the second bid; and

    o Select one of (i) the first bid, and (ii) the second bid (paragraph 101 where the bids are for the medical service that according to paragraph 93 could also be for prescriptions);

    o Such that

       ■ When the first bid is selected, the first pharmacy fills the prescription (paragraph 102 where the parties of the transaction are the winning bidders); and

       ■ When the second bid is selected, the second pharmacy fills the prescription (paragraph 102 where the parties of the transaction are the winning bidders).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into Munoz. One of ordinary skill in the art would have incorporated

these features into Munoz with the motivation to enable prospective clients/ patients and professional service providers to competitively negotiate fees for proffered services through an interactive on-line professional services auction transaction system implemented over a publicly accessible communications network such as the Internet (Henley abstract).

6.   As per claim 12, Munoz in view of Henley teaches the system of claim 1 as described above.   Munoz further teaches the system wherein the first pharmacy is one of a brick-and-mortar pharmacy and an online pharmacy (paragraph 67 where the local pharmacies are brick-and-mortar and a US pharmacy may be either brick-and-mortar and online or both brick-and-mortar and online and further where the pharmacy type is non-functional).

7.   As per claim 13, Munoz teaches a method for issuing a prescription comprising the steps of:

- Transmitting a prescription from a first computer by a physician (figure 14 for network design and paragraph 58 for the prescribing physician);

- Receiving the prescription on a server functionally distinct from the first computer (figure 14, server 332 and pc 306 or third party system 320), wherein the server is remote from the first computer (figure 14 where the server is connected through the Internet as discussed in paragraph 58) and is operated by a service provider (figure 14 #318 and paragraph 72 to show the computer is operated by the service provider);

- Retrieving the prescription from the server (figure 14 where the third party may be any number of third parties as described in paragraph 72);

- Submitting a first bid for the prescription to the server from a first pharmacy having a first pharmacy computer (67 where the bid results are compiled or stored);

- Submitting a second bid for the prescription to the server from a second pharmacy having a second pharmacy computer (67 where the bid results are compiled or stored);

- Storing the first bid and the second bid on the server (paragraph 100 where the global database is on the server);

- Transmitting the first bid and the second bid to a second computer (67 where the bid results are compiled or stored);

- Viewing the first bid and the second bid on the second computer (paragraph 67).

Munoz does not explicitly teach the method comprising

- Transmitting the first bid and the second bid to a second computer <u>operated by a patient;</u>

- <u>Making a selection consisting of one of (i) the first bid, and (ii) the second bid;</u>

- <u>Transmitting the selection to the server; and</u>

- <u>Informing one of (i) the first pharmacy, and (ii) the second pharmacy to fill the prescription.</u>

Munoz does not explicitly teach the method comprising

- Transmitting the first bid and the second bid to a second computer operated by a patient (figure 8 and paragraphs 63 and 83 where the buyer is a patient);

- Making a selection consisting of one of (i) the first bid, and (ii) the second bid (paragraph 101 where the bids are for the medical service that according to paragraph 93 could also be for prescriptions);

- Transmitting the selection to the server (paragraph 102 where the server makes the selection and the pharmacies notice the selection); and

- Informing one of (i) the first pharmacy, and (ii) the second pharmacy to fill the

  prescription (paragraph 102 where the parties of the transaction are the winning bidders).

It would have been obvious to one of ordinary skill in the art at the time of the invention to

incorporate these features into Munoz. One of ordinary skill in the art would have incorporated

these features into Munoz with the motivation to enable prospective clients/ patients and

professional service providers to competitively negotiate fees for proffered services through an

interactive on-line professional services auction transaction system implemented over a publicly

accessible communications network such as the Internet (Henley abstract).

8.   As per claim 16, Munoz in view of Henley teaches the method of claim 13 as described

above.   Munoz in view of Henley further teaches the method comprising the steps of

transmitting to the second computer at least one of:

- Contact information of one of (i) the first pharmacy, and (ii) the second pharmacy

  (paragraph 67);

- A set of directions from one of (i) the first pharmacy, and (ii) the second pharmacy to an

  address specified by the second computer; and

- A map-illustrating an address on the map of one of (i) the first pharmacy, and (ii) the

  second pharmacy.

9.   *Claims 2 – 9 and 14 – 15* are rejected under 35 U.S.C 103(a) as being unpatentable over

Munoz et al, U.S. Pre-Grant Publication Number 2002/ 0052760 in view of Henley, U.S. Pre-

Grant Publication 2003/ 0195838 as applied to claims 1 and 13 as above and further in view of

Hwangbo, U.S. Pre-Grant Publication Number 2003/ 0154376.

10.   As per claim 2, Munoz in view of Henley teaches the system of claim 1 as described above.

Munoz in view of Henley does not explicitly teach the electronic prescription handling system further comprising a portable storage medium configured to be interfaced with the first computer, wherein the portable storage medium includes an application for transmitting a digital certificate to the server when the portable storage medium interfaces with the first computer.

However, Hwangbo teaches the electronic prescription handling system further comprising

- A portable storage medium configured to be interfaced with the first computer (paragraph 1),

    o   Wherein the portable storage medium includes an application (paragraph 1)

        ▪   For transmitting a digital certificate (paragraph 1)

        ▪   To the server (figure 13)

        ▪   When the portable storage medium interfaces with the first computer (paragraph 67 where the certificates automatically access the server).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into Munoz in view of Henley. One of ordinary skill in the art would have incorporated these features into Munoz in view of Henley with the motivation to provide certification and security in electronic commerce (Hwangbo paragraph 1).

11.   As per claim 3, Munoz in view of Henley, further in view of Hwangbo teaches the system of claim 2 as described above.

Munoz in view of Henley does not explicitly teach the electronic prescription handling system
wherein the portable storage medium is one of (i) a CD-ROM, (ii) a DVD-ROM, and (iii) flash
memory.

However, Hwangbo teaches the electronic prescription handling system wherein the portable
storage medium is one of (i) a CD-ROM, (ii) a DVD-ROM, and (iii) flash memory (paragraph
1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to
incorporate these features into Munoz in view of Henley. One of ordinary skill in the art would
have incorporated these features into Munoz in view of Henley with the motivation to provide
certification and security in electronic commerce (Hwangbo paragraph 1).

12.   As per claim 4, Munoz in view of Henley, further in view of Hwangbo teaches the system
of claim 2 as described above.

Munoz in view of Henley does not explicitly teach the electronic prescription handling system
wherein the server is configured to authenticate the digital certificate.

However, Hwangbo teaches the electronic prescription handling system wherein the server is
configured to authenticate the digital certificate (figure 13).

It would have been obvious to one of ordinary skill in the art at the time of the invention to
incorporate these features into Munoz in view of Henley. One of ordinary skill in the art would
have incorporated these features into Munoz in view of Henley with the motivation to provide
certification and security in electronic commerce (Hwangbo paragraph 1).

13.   As per claim 5, Munoz in view of Henley, further in view of Hwangbo teaches the system

of claim 4 as described above.

Munoz further teaches the electronic prescription handling system wherein the server is

configured to transmit a prescription entry web page to the first computer upon the server

authenticating (paragraph 63 where the physician logs in).

Munoz does not explicitly teach the electronic prescription handling system wherein the server is

configured to transmit a prescription entry web page to the first computer upon the server

authenticating the digital certificate.

However, Hwangbo teaches the electronic prescription handling system wherein the server is

configured to transmit a prescription entry web page to the first computer upon the server

authenticating the digital certificate (paragraph 87 where the mall is a web entry page as

described in paragraph 33 where the medium is pre-inserted).

It would have been obvious to one of ordinary skill in the art at the time of the invention to

incorporate these features into Munoz in view of Henley. One of ordinary skill in the art would

have incorporated these features into Munoz in view of Henley with the motivation to provide

certification and security in electronic commerce (Hwangbo paragraph 1).

14.   As per claim 6, Munoz in view of Henley, further in view of Hwangbo teaches the system

of claim 5 as described above.

Munoz further teaches the system wherein

- A pharmaceutical database for storing a plurality of drug formularies therein (paragraph

  64).

Munoz does not explicitly teach the system wherein

- A physician database <u>utilized to authenticate the digital certificate.</u>

However, Hwanbo teaches the system wherein

- A physician database utilized to authenticate the digital certificate (paragraph 115 where
  the user is a physician).

It would have been obvious to one of ordinary skill in the art at the time of the invention to

incorporate these features into Munoz in view of Henley. One of ordinary skill in the art would

have incorporated these features into Munoz in view of Henley with the motivation to provide

certification and security in electronic commerce (Hwangbo paragraph 1).

15.   As per claim 7, Munoz in view of Henley, further in view of Hwangbo teaches the system

of claim 6 as described above.

Munoz further teaches the system wherein the server comprises:

- A prescription database for storing the prescription received from the first computer
  (figure 14 where database 304 or database 334 stores the information);

- A patient database for storing patient information (figure 14 where database 304 or
  database 334 stores the information);

- A pharmacy database for storing pharmacy data (figure 14 where database 304 or
  database 334 stores the information); and

- A bid database for storing the first bid and the second bid (figure 14 where database 304
  or database 334 stores the information).

16.   As per claim 8, Munoz in view of Henley, further in view of Hwangbo teaches the system

of claim 7 as described above.

Munoz further teaches the system wherein the patient information comprises at least one of (i) an insurance provider identifier for the patient, (ii) a medical history for the patient, (iii) a drug interaction list for the patient, and (iv) an allergic reaction list for the patient (figure 13 where the insurance company and patient history is entered).

17.   As per claim 9, Munoz in view of Henley, further in view of Hwangbo teaches the system of claim 7 as described above.

Munoz further teaches the system wherein the pharmacy data comprises contact information for one of (i) the first pharmacy and, (ii) the second pharmacy (paragraph 67).

18.   As per claim 14, Munoz in view of Henley teaches the method of claim 13 as described above.

Munoz in view of Henley does not explicitly teach the steps of:

*   <u>Interfacing a portable storage medium with the first computer, wherein the portable storage medium includes an application for transmitting a digital certificate; and</u>

*   <u>Transmitting the digital certificate to the server.</u>

Chan teaches the steps of:

*   Interfacing a portable storage medium with the first computer (paragraph 1), wherein the portable storage medium includes an application (paragraph 1) for transmitting a digital certificate (paragraph 1); and

*   Transmitting the digital certificate to the server (figure 13).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into Munoz in view of Henley. One of ordinary skill in the art would

have incorporated these features into Munoz in view of Henley with the motivation to provide

certification and security in electronic commerce (Hwangbo paragraph 1).

19.   As per claim 15, Munoz in view of Henley, further in view of Hwangbo teaches the

method of claim 14 as described above.

Munoz further teaches the step of transmitting a prescription entry web page to the first computer

(paragraph 63 where the physician logs in).

Munoz does not explicitly teach the step of <u>authenticating the digital certificate on the server.</u>

However, Hwangbo teaches the step of authenticating the digital certificate on the server

(paragraph 87 where the mall is a web entry page as described in paragraph 33 where the

medium is pre-inserted).

It would have been obvious to one of ordinary skill in the art at the time of the invention to

incorporate these features into Munoz in view of Henley. One of ordinary skill in the art would

have incorporated these features into Munoz in view of Henley with the motivation to provide

certification and security in electronic commerce (Hwangbo paragraph 1).

20.   *Claims 10 and 11* are rejected under 35 U.S.C 103(a) as being unpatentable over Munoz

et al, U.S. Pre-Grant Publication Number 2002/ 0052760 in view of Henley, U.S. Pre-Grant

Publication 2003/ 0195838 as applied to claim 1 above and further in view of Hwangbo, U.S.

Pre-Grant Publication Number 2003/ 0154376 as applied to claims 2 through 9 above, and

further in view of McCormick, U.S. Pre-Grant Publication Number 2002/0035484.

21.   As per claim 10, Munoz in view of Henley, further in view of Hwangbo teaches the

system of claim 9 as described above.

Munoz in view of Henley, further in view of Hwangbo do not explicitly teach the system

wherein the server is further configured to transmit at least one of (i) an address of the first

pharmacy or second pharmacy, and (ii) a set of directions from the first pharmacy or second

pharmacy to an address specified by the second computer.

However, McCormick teaches the electronic prescription handling system wherein the server is

further configured to transmit at least one of (i) an address of the first pharmacy or second

pharmacy, and (ii) a set of directions from the first pharmacy or second pharmacy to an address

specified by the second computer (paragraph 89).

It would have been obvious to one of ordinary skill in the art at the time of the invention to

incorporate this feature into Munoz in view of Henley, further in view of Hwangbo. One of

ordinary skill in the art would have incorporated this feature Munoz in view of Henley, further in

view of Hwangbo with the motivation to eliminate inefficiencies at the doctor's office in

generating the prescription (McCormick paragraph 5).

22.   As per claim 11, Munoz in view of Henley, further in view of Hwangbo teaches the

system of claim 10 as described above.

Munoz in view of Henley, further in view of Hwangbo does not explicitly teach the electronic

prescription handling system wherein the server is further configured to transmit a map

illustrating the address on the map of one of (i) the first pharmacy, and (ii) the second pharmacy.

However, McCormick teaches the electronic prescription handling system wherein the server is

further configured to transmit a map illustrating the address on the map of one of (i) the first

pharmacy, and (ii) the second pharmacy (paragraph 90).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into Munoz in view of Henley, further in view of Hwangbo. One of ordinary skill in the art would have incorporated this feature Munoz in view of Henley, further in view of Hwangbo with the motivation to eliminate inefficiencies at the doctor's office in generating the prescription (McCormick paragraph 5).

23.   *Claims 17 – 22* are rejected under 35 U.S.C 103(a) as being unpatentable over Henley, U.S. Pre-Grant Publication Number 2002/0065758 in view of Chan et al., U.S. Pre-Grant Publication Number 2001/0039503 and Babowicz et al., U.S. Pre-Grant Publication Number 2005 / 00390032.

24.   As per claim 17, Henley teaches an electronic prescription handling system comprising:

- A computer (paragraph 32);

- A server communicatively connected to the computer (paragraph 32);

- Further wherein a user of the computer enters a prescription (paragraph 93 where a medical service is defined as a pharmacy) into the prescription entry web page (and paragraph 94 where the prescription service is entered), and thereafter the computer transmits the prescription to the server (paragraph 94).

Henley does not explicitly teach an electronic prescription handling system comprising:

- A portable storage medium configured to interface with the computer;

- An application residing on the portable storage medium, wherein the computer is configured to automatically execute the application once the portable storage medium interfaces with the computer, wherein the application includes a file associated therewith for instructing the computer to execute the application, further wherein the application is

configured to transmit a digital certificate to the server upon the application sensing a
network connection to the server; and

- Means for authenticating the digital certificate on the server, wherein when the digital
certificate is positively authenticated, the server transmits a prescription entry web page
to the computer.

However, Chan teaches an electronic prescription handling system comprising:

- A portable storage medium configured to interface with the computer (paragraph 83
where the portable medium is a CD-ROM);

- An application residing on the portable storage medium (paragraph 83 where the software
is stored on the CD-ROM), and

- Means for authenticating the digital certificate on the server (paragraph 73), wherein
when the digital certificate is positively authenticated (paragraph 73), the server transmits
a prescription entry web page to the computer (paragraph 65 where the GUI is a web
page and the level is restricted to the physician).

And Babowicz teaches an electronic prescription handling system comprising:

- An application residing on the portable storage medium (paragraph 26),
   o Wherein the computer is configured to automatically execute the application once
      the portable storage medium interfaces with the computer (paragraph 26, auto-run
      file),
   o Wherein the application includes a file associated therewith for instructing the
      computer to execute the application (paragraph 26 auto-run information file),
      further

      o Wherein the application is configured to transmit a digital certificate to the server upon the application sensing a network connection to the server (paragraph 27, secret key).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into Henley.

One of ordinary skill in the art would have motivated to incorporate these features into Henley to facilitate access to and utilization of the associated data stores and resources by the major participants in the health and wellness program (Chan paragraph 9) and to provide local use of an authentication program running on the client, who reduces communications and processing demands of the server (Babowicz Abstract).

25.   As per claim 18, Henley in view of Chan and Babowicz teach the system of claim 17 as described above.

Henley does not explicitly teach the electronic prescription handling system <u>wherein the portable storage medium is one of (i) a CD-ROM, (ii) a DVD-ROM, and (iii) flash memory.</u>

However, Chan teaches the electronic prescription handling system wherein the portable storage medium is one of (i) a CD-ROM, (ii) a DVD-ROM, and (iii) flash memory (paragraph 83 where the portable storage medium is a CD-ROM).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into Henley in view of Chan and Babowicz. One of ordinary skill in the art would have motivated to incorporate this feature into Henley in view of

Chan and Babowicz to facilitate access to and utilization of the associated data stores and

resources by the major participants in the health and wellness program (Chan paragraph 9).

26.   As per claim 19, Henley in view of Chan and Babowicz teach the system of claim 17 as

described above.

Henley does not explicitly teach the electronic prescription handling system wherein <u>the digital</u>

<u>certificate identifies a physician</u>.

However, Chan teaches the electronic prescription handling system wherein the digital certificate

identifies a physician (paragraph 73 where the user is a physician).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the

invention to incorporate this feature into Henley in view of Chan and Babowicz. One of

ordinary skill in the art would have motivated to incorporate this feature into Henley in view of

Chan and Babowicz to facilitate access to and utilization of the associated data stores and

resources by the major participants in the health and wellness program (Chan paragraph 9).

27.   As per claim 20, Henley in view of Chan and Babowicz teach the system of claim 18 as

described above.

Henley does not explicitly teach the electronic prescription handling system wherein the <u>digital</u>

<u>certificate is hidden on the portable storage medium</u>.

However, Babowicz teaches the electronic prescription handling system wherein the digital

certificate is hidden on the portable storage medium (paragraph 27 where the key is a secret key

and paragraph 24 where the contents of the disk are copy protected. Additionally, it should be

pointed out that any file on the portable storage medium cannot be seen without a reading device

and so by default are hidden).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into Henley in view of Chan and Babowicz. One of ordinary skill in the art would have motivated to incorporate this feature into Henley in view of Chan and Babowicz to provide local use of an authentication program running on the client, who reduces communications and processing demands of the server (Babowicz Abstract).

28.   As per claim 21, Henley in view of Chan and Babowicz teaches the system of claim 20 as described above.

Henley does not explicitly teach the electronic prescription handling system wherein the <u>digital certificate cannot be copied from the portable storage medium.</u>

However, Babowicz teaches the electronic prescription handling system wherein the digital certificate cannot be copied from the portable storage medium (paragraph 24 where the files are copy protected).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into Henley in view of Chan and Babowicz. One of ordinary skill in the art would have motivated to incorporate this feature into Henley in view of Chan and Babowicz to provide local use of an authentication program running on the client, who reduces communications and processing demands of the server (Babowicz Abstract).

29.   As per claim 22, Henley in view of Chan and Babowicz teaches the system of claim 19 as described above. Henley further teaches the electronic prescription handling system wherein the server transmits the prescription to a pharmacy (paragraph 93 where plurality includes a first pharmacy computer).

Response to Arguments

30.   Applicant's arguments filed 7/7/2008 have been fully considered but they are not

persuasive.

31.   Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a

general allegation that the claims define a patentable invention without specifically pointing out

how the language of the claims patentably distinguishes them from the references.

32.   In regard to whether the claimed invention "inherently" shows a reverse auction, the

Examiner notes that there are several definitions of reverse auctions (Dutch auction definition as

an alternative) and therefore the inherency argument is not persuasive. The Applicant has failed

to incorporate his definition into the claimed invention.

However, had the Applicant chosen to claim his invention to incorporate a reverse auction, the

Examiner notes the first line from Kalies, U.S. Pre-Grant Publication 2005/ 0065821, abstract:

- Unfilled prescriptions are submitted to a registry comprising pre-qualified pharmacies for

  a "reverse auction" in which the pharmacies bid for the opportunity to fill the

  prescription.

33.   Applicant's arguments with respect to claims 17 - 21 have been considered but are moot

in view of the new ground(s) of rejection.

34.   The Applicant is reminded to review recent U.S. Supreme court rulings before making

additional amendments. In particular, KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385

(2007) where:

       a.   The elements are all known but not combined as claimed. The technical ability

               exists to combine the elements as claimed and the results of the combination are

predictable. When combined, the elements <u>perform the same function as they did</u> <u>separately</u>.

Conclusion

35.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NEAL R. SEREBOFF whose telephone number is (571)270-1373. The examiner can normally be reached on Mon thru Thur from 7:30am to 5pm, with 1st Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Luke Gilligan can be reached on (571) 272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. R. S./
Examiner, Art Unit 3626
9/26/2008

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626